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Reply to Office Action of August 22, 2005

REMARKS/ARGUMENTS

Claims 1-12, and 14-19 were presented for examination and are pending in this application. In an Official Office Action dated August 22, 2005, claims 1-12, and 14-19 were rejected. Claim 19 is herein canceled without prejudice. The Applicants thank the Examiner for his consideration and address the Examiner's comments concerning the claims pending in this application below. Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and withdraw them.

35 U.S.C. §103(a) Obviousness Rejection of Claims

Claims 1-8, 11-12, 14-16 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,691,165 ("Bruck"). Claim 9, 10, 17 and 19 were rejected under 35 U.S.C. §102(a) as being unpatentable over Bruck in view of U.S. Patent No. 5,956,489 ("San Andres"). Applicants respectfully traverse these rejections in light of the following remarks and respectfully request reconsideration.

MPEP §2143 provides:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The cited references fail to teach or suggest all of the limitations recited in the claims as currently amended. For example, independent claim 1 recites among other things, "a gateway machine coupled to the network in communication with the

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client and separate from the servers....” Similarly, independent claim 12 recites, “wherein the gateway machine is separate from the plurality of servers.”

The Examiner recognizes that Bruck fails to teach and suggest all of the claim limitations. In the USPTO communication dated August 22, 2005, the Examiner admits that Bruck “does not explicitly disclose [a] system’s structure that has a gateway separate from [a] server.” USPTO Communication dated August 22, 2005 page 3. The Examiner also asserts that “having a computer to function as a gateway ... separated from a computer, server or web server, would have been [a] matter of design choice.” *Id.* The Examiner fails, however, to recognize that the separation between the servers and the gateway is a critical limitation tied directly to the operativeness of the invention.

The Examiner states that because “separating functionality, as taught by Bruck, from a computer could easily be done, regardless of computer location ... without involving an inventive concept and without producing unexpected results, [the invention] would have been [an] obvious matter of choice, which [the] court held unpatentable (See MPEP 2144.04 (V))”. *Id.* The Applicants respectfully disagree with the Examiner’s conclusion.

The Applicants’ invention, by separating the gateway from the server and placing the gateway communicatively between the client and the server, inherently decreases the latency between the client and the gateway and enables the invention to balance server loads more effectively. This point is clearly explained in the specification beginning at the bottom of page 12 and continuing onto page 13. The Applicants state:

Front-end mechanism 201 serves as an access point for client-side communications. Front-end 201 implements a gateway that functions as a proxy for the web server(s) implementing web site 210 (i.e., from the perspective of

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client 205, front-end 201 appears to be the web site 210). Front-end 201 comprises, for example, a computer that sits "close" to clients 205. By "close", it is meant that the average latency associated with a connection between a client 205 and a front-end 201 is less than the average latency associated with a connection between a client 205 and a web site 210. Desirably, front-end computers have as fast a connection as possible to the clients 205. For example, the fastest available connection may be implemented in point of presence (POP) of an Internet service provider (ISP) 106 used by a particular client 205.

Briefly stated, the positioning of the gateway between server and the client in a separate machine is a critical limitation that enables the claimed system to reduce latency, balance the load amongst the servers providing redundant resources, and balance the load across the plurality of communication channels.

The Examiner's reliance on MPEP 2144.04 (V) is misplaced. MPEP 2144.04 provides several examples of common practice which the Court has held normally require[s] only ordinary skill in the art; one of which is making the invention separable. See MPEP 2144.04 (V)(C). The case cited in subsection 2144.04 (V)(C) is *In re Dulberg*, 48 C.C.P.A. 992, 289 F.2d 522, 129 USPQ 348 (Cust. & Pat.App.1961). In *Dulberg*, the Court considered a lipstick holder that was fully met by the Peterson patent except for a removable cap (which allowed access to the bottom end of the tube for easier removal and replacement of lipstick). See *id.*, 289 F.2d at 523. The Court upheld the rejection of the patent, holding that "if it were considered desirable for any reason to obtain access to the end of Peterson's holder to which the cap is applied, it would be obvious to make the cap removable for that purpose." *Dulberg*, 289 F.2d at 522. The *Dulberg* Court further held that "[n]o specific prior art teaching would be necessary to show this operation."

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Dulberg, 289 F.2d at 523. Nevertheless, for good measure the Court also combined Peterson and a patent structurally similar to Peterson (the Noble patent), which contained a removable cap. *Id.* This holding however is not without its limitations.

The holding in *Dulberg* was explained in *For Your Ease Only, Inc. v. Natural Science Industries, Inc.*, 233 F.Supp.2d 988, *991 -993 (N.D.Ill., 2002). In *For Your Ease Only*, Natural Science Industries ("NSI") argued that the For Your Ease Only Inc, Patent, U.S. Patent No. 6,325,211 ("the 211 patent"), was invalid. NSI argued that the 211 patent was invalid because "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. §103(a) (2002). NSI asserted that the claims of the '211 patent were fully met by the Joly Marion bowl, (prior art) except for the addition of a removable (separable) bottom plate. NSI further argued that under the Manual of Patent Examining Procedure, Section 2144.04, such a separation is a *prima facie* obvious modification unless For Your Ease Only, Inc. establishes the "criticality" of the limitation. In support of this argument, NSI cited the Manual of Patent Examining Procedure Section 2144.04, which allows an examiner to make an obviousness determination based only on "sufficiently similar" case law. But the Court stated, "[i]f the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection." *Id.*

The Court reasoned "that on the one hand, the Fill-A-Bowl® products are distinguishable from the lipstick holder in *Dulberg*. A lipstick holder with a removable cap remains a mere lipstick holder. A Joly Marion bowl with a removable bottom plate remains a bowl, but it is also a craft project: it allows the user to engage in a creative activity. Therefore, while the removable cap in *Dulberg* is, in the language of MPEP Section 2144.04, a "routine expedient," the removable

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bottom plate of the Fill-A-Bowl is a critical limitation." 233 F.Supp.2d at 992.

NSI insisted that a limitation is only "critical" if it "leads to a new result which would not be expected by those of ordinary skill in the art." (Def.'s Objections) (quoting *In re Reni*, 57 C.C.P.A. 857, 419 F.2d 922, 925 (Cust. & Pat.App.1970)). The Court in *For Your Ease Only* held differently stating that "a 'critical limitation' is customarily understood as 'one essential either to the operativeness of the invention or to the patentability of the claims.' *Storchheim v. Daugherty*, 410 F.2d 1393, 1396, 56 C.C.P.A. 1147, 1150 (Cust. & Pat.App.1969); see also Black's Law Dictionary (7th ed.1999) (same definition). The removable bottom plate is essential to the operativeness of the Fill-A-Bowl® line and, if patentable, to its patentability." *Id.*

The Court also pointed out that the claims of the '211 patent were distinguishable from the claims considered in *Dulberg*, which were directed only toward the structure of the proposed invention, not the method of removing the lipstick (which was to push the old lipstick out with "a pencil or similar instrument"). *Dulberg*, 289 F.2d at 523. In contrast, the '211 patent is directed "to a decorative *993 container ... and to a method for decorating a container." (See U.S. Patent No. 6,325,211 B1, Field of the Invention.) Unlike the claims in *Dulberg*, therefore, the claims of the '211 patent involve method, not only a simple structural change. *Dulberg* does not "espouse a general principle that removability cannot make an invention...." *Id.* The Court therefore held that because the removability limitation is critical to the '211 patent, it would not be appropriate, under MPEP 2144.04, to rely solely on *Dulberg* for an obviousness rejection.

In the Applicants' invention, the limitation of claims 1 and 12 separating the gateway from the server is essential to the operativeness of the invention and is therefore a critical element. Just as NSI's reliance on MPEP 2144.04 was deemed inappropriate, so is the Examiner's reliance on MPEP 2144.04 (V)(C) misplaced. Separation between the servers and the gateway, as claimed by the Applicants, is a

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critical limitation tied directly to the operativeness of the invention. MPEP 2144.04 can not be relied upon to find such a limitation obvious. Furthermore, claim 12 is a method claim. As indicated by the Court, MPEP 2144.04 can not be applied to a method patent. The Applicants respectfully submit that independent claims 1 and 12 are in condition for allowance and requests the Examiner withdraw the rejection and allow the claims. Claim 2-11 and 14-18 depend from claims 1 and 12 respectively and are for at least the same reasons patentable over Bruck. In light of the aforementioned remarks, the Examiner's rejection of claims 9, 10, and 17 as being unpatentable over Bruck in view of San Andres are moot.

In view of all of the above, the claims are now believed to be allowable and the case in condition for allowance which action is respectfully requested. Should the Examiner be of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is requested to contact Applicants' attorney at the telephone number listed below.

No fee is believed due for this submittal. However, any fee deficiency associated with this submittal may be charged to Deposit Account No. 50-1123.

Respectfully submitted,

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